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09/981,885	10/17/2001	Robert E. Haines	10013718-1	7082

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/981,885

Applicant(s)

HAINES, ROBERT E.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 32-34, 38-39, 41-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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sheet, the marking continuous from the face of the sheet to the edge of the sheet”. Based on this contradiction, claim 3 could be a different invention and would be distinct from claim 1, thereby requiring a restriction.

7. Claims 3, 34, and 43 recite “the sheet has sufficient capillary action properties to carry the fluid-based marking onto the face from the edge”, while claim 34 recites the sheet does not. It is not clear how this accomplished. Furthermore, according to the instant disclosure, description of Fig. 5 on page 8, lines 7+, the fluid based ink marking possesses this characteristic and not the sheet (see also instant claim 34 claiming the sheet does not have sufficient capillary action). Additionally it is not clear how the fluid based marking is on the sheet by capillary action and imprinted on the edge and not the face.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by  
USPN 6,090,027 to Brinkman.

Brinkman teaches a sheet of print media (Brinkman, Fig. 14A-14C, 16A-16C and associated text), the sheet comprising: face; edge; a fluid-based marking positioned on a the face

### **DETAILED ACTION**

1. The cancellation of claims 2, 6-31, 35-37, and 40 are acknowledged.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3, 32, 34, 39, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1 and 39 recite “the single fluid-based marking comprises data for configuring an imaging device”, and “the data is for configuring the image device to form images on the sheet”, respectively, however, Applicant’s specification on page 9, lines 17-19 recite the image forming device is configured to form images upon print media. Thus it is not clear how said marking comprises data for configuring an image device or how data configures an image device. Further, to say “configure” is vague and confusing. How does fluid ink “configure” a device, or image device? Does ink turn on the image device? How and what steps are involved to “configure” a fluid-based marking to an image device?

5. Further to claims 1, 32, and 39, “the marking continuous from the face of the sheet to the edge” is not clear. The marking is imprinted, thereby making it incapable of being continuous. Printing operations imprint discontinuous markings.

6. Claim 3 recites “the fluid-based marking being imprinted on the edge portion and not imprinted on the face portion”. This is confusing and appears contradictory, as claim 3 depends on claim 1 that states the fluid-based marking on the face of the sheet **and** on the edge of the

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and/or from the edge, the edge covering an area that is adjacently positioned and substantially perpendicular to an area of the face; and wherein the fluid-based marking comprises data for configuring an imaging device for printing on the sheet from the face and/or from the edge (Brinkman, Abstract and col. 21, lines 10-20).

Regarding claim 2, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is positioned on the face and on an adjacent and substantially perpendicular edge; and wherein the fluid-based marking comprises data for configuring operations of the imaging device for printing on the sheet (Brinkman, Fig. 14A-14C, 16A-16C and associated text).

Regarding claim 3, Brinkman teaches a sheet as recited in claim 1, wherein the fluid-based marking is imprinted on the edge and not imprinted on the face, (Brinkman, col. 8, lines 37-40, the ink may or may not be on the sheet).

Regarding claim 4, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is ink (Brinkman, Abstract and col. 21, lines 10-20).

Further regarding claim 1, Brinkman teaches a sheet as recited in claim 1, wherein the data is for configuring the image device to form images on the sheet for printing on the sheet (Brinkman, Fig. 14A-14C, 16A-16C and associated text), as ink is on the sheet. Further, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed invention from a prior art invention satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Instant claims 1, 3-4, and 41-43 are met.

Claims 1 3-4, and 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,598,783 to Brinkman.

Brinkman teaches a sheet of print media (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text), the sheet comprising the sheet comprising: face; edge; a fluid-based marking positioned on a the face and/or from the edge, the edge covering an area that is adjacently positioned and substantially perpendicular to an area of the face; and wherein the fluid-based marking comprises data for configuring an imaging device for printing on the sheet from the face and/or from the edge (Brinkman, Abstract and col. 2, lines 22-35).

Regarding claim 2, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is positioned on the face and on an adjacent and substantially perpendicular edge; and wherein the fluid-based marking comprises data for configuring operations of the imaging device for printing on the sheet (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text).

Regarding claim 3, Brinkman teaches a sheet as recited in claim 1, wherein the fluid-based marking is imprinted on the edge and not imprinted on the face, (Brinkman, 41, Fig. 6B and associated text).

Regarding claim 4, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is ink (Brinkman, Abstract and col. 2, lines 22-35).

Further regarding claim 1, Brinkman teaches a sheet as recited in claim 1, wherein the data is for configuring the image device to form images on the sheet for printing on the sheet (Brinkman, Fig. 14A-14C, 16A-16C and associated text), as ink is on the sheet. Further, it has

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been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed invention from a prior art invention satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 32, 34, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,598,783 to Brinkman.

Brinkman essentially teaches the claimed invention relied upon above.

To claim 32, Brinkman teaches fluid marking continuous from the face to the edge representing machine readable data (IFE 31, FIG. 7C and associated text, e.g. marking of ink imprinted for scanning (a scanner is a machine that reads data). See also col. 6, lines 20-55.

Brinkman does not teach claims 5, 32, and 38 to a plurality and/or adjoining faces and/or edges or to a stack of print media comprising a plurality of sheets, each sheet being a sheet as recited in claim 1.

Unless the reference teaches away from duplicating said sheet, it is obvious to provide a plurality of faces, edge adjoining faces and sheets as claim 1 or 32 motivated by the desire of providing multiple markings for identification. Additionally, the mere duplication of parts has

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no patentable significance unless a new and unexpected result is produced. Further a plurality of faces is taught as Brinkman shows a top and bottom face and plurality of edges adjoining each top and bottom face (Fig. 7s, col. 5, line 1).

To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking, the Examiner interprets that the sheet of the prior art does not have sufficient capillary action.

To claim 39, how markings were generated by various process and that each of the sheets are being skewed at an angle are process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 5, 32-34, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,090,027 to Brinkman.

Brinkman essentially teaches the claimed invention relied upon above.

Brinkman does not teach claims 5, 32, and 38 to a plurality and/or adjoining faces and/or edges or to a stack of print media comprising a plurality of sheets, each sheet being a sheet as recited in claim 1.

Unless the reference teaches away from duplicating said sheet, it is obvious to provide a plurality of facial portions, edge portions and sheets as claim 1 or 32 motivated by the desire of



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providing multiple markings for identification at more than one location. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Further a plurality of faces is taught as Brinkman shows a top and bottom face and plurality of edges adjoining each top and bottom face (See all Figures).

To Claim 33, Brinkman teaches the fluid-based marking is a barcode (col. 21, lines 16-35).

To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking, the Examiner interprets that the sheet of the prior art does not have sufficient capillary action.

To claim 39, how markings were generated by various process and that each of the sheets are being skewed at an angle are process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 29 531. Both Applicant's and prior art reference's product are the same.

### ***Response to Arguments***

10. Applicant's arguments have been considered but are not persuasive.
11. Applicant argues the 112, second paragraph rejections. Applicant has not amended the claims to provide clarity to the fluid marking configuring an image device (claims 1 (amended)

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and 31 (canceled), now further addressing claim 39 (amended)) and the contradictory claim 3 to the marking not on the edge when in claim 1 it is on the edge. The Examiner has further provided direction above to this point as Applicant requested. The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. Further to the confusion of how the fluid marking is imprinted on the face and not on the edge, Applicant actually argues the marking is “imprinted on the edge” on page 5 in the last paragraph of the Remarks, what happens afterward, “bleeds from edge to the face” is inherently present. Thus because the specification and Applicant has admitted the marking is indeed imprinted on the edge (claims 1 and 39), it is contradictory to claim it is not on the edge (claim 3).

Applicant argues Brinkman ‘027 or ‘783 does not teach the instant invention. Applicant points to the amendment made to include “for printing on the sheet”. However, that the ink is for certain applications is to intended use and is not germane to patentability as indicated above. Applicant argues that the type of information is for pricing an item, not for machine readable data. However, while Brinkman ‘027 and ‘783 teach ink information for pricing, Applicant also teaches the ink is scanned and readable by laser or scan which indicates a machine is used. Further both Brinkman disclose the use of imprinted bar codes and bar codes are read by a machine (Brinkman ‘783 –col. 4, lines 35-41; Brinkman ‘027-col. 21, lines 16-35).

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12. Applicant argues that both Brinkmans teach marking imprinted on a label, a box, or envelope and being folded, but not a sheet. A label, box, or envelope is indeed a sheet. "A sheet" is broad enough to encompass any type of sheet. Applicant has not amended the claims to exclude folds or specify what type of sheet is intended but is welcomed to do so.

13. Applicant argues neither Brinkman teaches sufficient capillary action. Applicant is not clear in claiming what does or does not have the capillary action. Secondly, the same material is taught, therefore, it must inherently have the same properties, absent evidence to the contrary.

14. Applicant argues neither Brinkman teaches each sheet in the stack being skewed at an angle to expose sheets. Again, these limitations are product by process language and is given little patentable weight because the same elemental structure is provided by the prior art.

### ***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

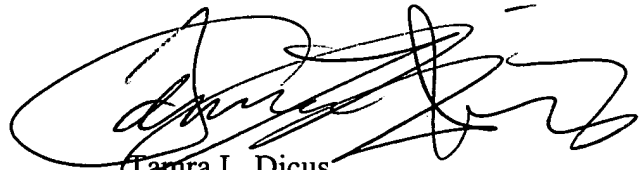
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

November 1, 2005



RENA DYE  
SUPERVISORY PATENT EXAMINER

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